

ESTTA Tracking number: **ESTTA40229**

Filing date: **07/28/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164879
Party	Plaintiff TEV LAW GROUP, P.C. Zegarelli Law Group 429 Forbes Avenue Suite 1212 Pittsburgh, PA 15219-1616 UNITED STATES
Correspondence Address	Gregg R. Zegarelli, Esq. TEV LAW GROUP, P.C. 429 FORBES AVENUE, 12TH FLOOR PITTSBURGH, PA 15219-1616 UNITED STATES mailroom.grz@zegarelli.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Gregg Zegarelli
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Signature	/Gregg Zegarelli/
Date	07/28/2005
Attachments	Motion to Stay w Exhibits.pdf (17 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial 78/321,694, filed October 31, 2003, by Exipert, Inc. for the trademark

"CHECKMARK NETWORK"

TECHNOLOGY & ENTREPRENEURIAL
VENTURES LAW GROUP, PC.

Opposer,

v.

EXIPERT, INC.,

Applicant.

: OPPOSITION NO. 91,164,879
:
: Date: July 28th, 2005
:
: FILED ELECTRONICALLY - ESTTA
:
:
: I hereby certify that this document was filed by ESTTA on July 28, 2005.
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: /Gregg R. Zegarelli/
: Gregg R. Zegarelli
: Counsel for Opposer
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MOTION TO SUSPEND PROCEEDINGS

In the matter of the above-identified application:

Technology & Entrepreneurial Ventures Law Group, PC, a Pennsylvania professional corporation having a principal place of business at Allegheny Building, 12th Floor, Pittsburgh, PA 15219-1616, USA, hereby requests that the Board grant a suspension of the above-captioned opposition pursuant to 37 C.F.R §2.117(a) as a result of a pending action in the United States District Court for the Western District of Pennsylvania, Technology & Entrepreneurial Ventures Law Group, PC v. Exipert, Inc., Case No.: 05-1026 which will have a bearing on this opposition. A copy of the pleadings of record are attached hereto as Exhibit A.

The gist of this opposition and the federal lawsuit is that Opposer has been selling intellectual property related services under the designation "CheckMark." Opposer's CheckMark services include search and watch services for trademarks. Opposer has been advertising and taking orders for the services in interstate commerce since at least as early as December, 1994. Applicant is seeking to register "CheckMark Network" for

the same or similar services with a first use date of 2001. Accordingly, Opposer has priority of use.

In order to resolve all issues arising from, related to and in connection with the rights of Opposer relating to the mark in question, Opposer instituted the aforementioned federal lawsuit. Because the federal court will be addressing a superset of the issues before the Board, including but not limited to, priority of use, infringement, damages, unfair competition, violations of state and federal statutes, etc., the federal court is the most efficient forum in which to resolve the dispute.

The same subject matter, issues, testimony and other evidence, in the lawsuit would be involved in the opposition as in the pending federal lawsuit.

If the motion to suspend the opposition is not granted by the Board, then significant duplication of proceedings would occur, the procedural posture of the proceedings would grow more complex, and the cost to the parties and the United States Government would increase significantly.

WHEREFORE, Opposer hereby requests that this proceeding be suspended under 37 C.F.R. 2.117 pending the determination in the lawsuit Technology & Entrepreneurial Ventures Law Group, PC v. Exipert, Inc., Case No.: 05-1026. in the United States District Court for the Western District of Pennsylvania.

July 28, 2005

Respectfully submitted,

/Gregg R. Zegarelli/
Gregg R. Zegarelli, Esq.
Attorney for Opposer

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Motion to Suspend has been served by United States first class mail, postage pre-paid or by overnight delivery this 28th day of July, 2005, upon the following counsel of record or applicant:

Eric T. Fingerhut, Esq.
Howrey LLP
1299 Pennsylvania Ave., NW
Washington, D.C. 20004, USA

Respectfully submitted,

/Gregg R. Zegarelli/

Gregg R. Zegarelli, Esq..
Pa. I.D. #52717

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IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

TECHNOLOGY & ENTREPRENEURIAL VEN-
TURES LAW GROUP, PC, a Pennsyl-
vania professional corporation,

CIVIL ACTION NUMBER: 05-1026

Plaintiff,

v.

EXIPERT, INC., a New Jersey corpo-
ration,

Defendant.

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff, TECHNOLOGY & ENTREPRENEURIAL VENTURES LAW GROUP, PC
(sometimes, "TEV LAW GROUP"), for its Complaint states:

THE PARTIES

1. TEV LAW GROUP is a Pennsylvania professional corporation
with its principal place of business at 429 Forbes Avenue, 12th Floor,
Pittsburgh PA 15219, USA.

2. EXIPERT, INC. ("Defendant"), is a New Jersey corporation
with its principal place of business at 323 Washington Street, Hoboken,
NJ, USA.

NATURE OF ACTION

3. TEV LAW GROUP is the exclusive owner of the trademark "CHECKMARK" (the "Mark"), and, subject to the claims as set forth herein, this is an action generally for trademark infringement, dilution of trademark rights, unfair competition and conversion.

JURISDICTION

4. This Court has subject matter jurisdiction over this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. § 1331, 1338(a) and (b), federal questions involving infringement of a mark, joined with claims for unfair competition. Pendant jurisdiction over other claims arising from the same nucleus of operative facts lies in consideration of judicial economy, convenience, and fairness to litigants.

JURISDICTION AND VENUE

5. The venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and (c).

STATEMENT OF FACTS

6. TEV LAW GROUP, by assignment from as successor-in-interest from and to Zegarelli Associates, is the owner of all right, title and interest in and to the Mark, which is registered with the Commonwealth of Pennsylvania and an application is pending with the United States Patent and Trademark Office.

7. As well long ago as on December, 1994, TEV LAW GROUP began advertising intellectual property-related services and taking orders using the Mark in interstate commerce, placing the world on public legal notice of the claim to the Mark. See Exhibit A attached hereto and made a part hereof. TEV LAW GROUP has continued to advertise and use the mark

in interstate commerce since said date in conjunction with its intellectual property services.

8. TEV LAW GROUP has used contributed significant time, money and effort to establishing business and good will associated with the Mark, specifically regarding intellectual property search and watch services.

9. (a) Defendant has filed for a federal trademark registration for "Checkmark Network" claiming exclusive ownership for intellectual property search and watch services. Defendant purposefully, intentionally and willfully attempted to add the term "network" knowing that Defendant's term continues to absolutely create an association and confusion in the marketplace, and causes significant dilution to the value of the Mark.

(b) By said application, Defendant has admitted its infringement.

(c) By said activity, Defendant has intentionally, recklessly and wantonly engaged in a course of conduct that has damaged TEV LAW GROUP.

(d) Defendant's infringement of the Mark would cause or is causing great damage to TEV LAW GROUP and the aforesaid use by Defendant an admission of harm to TEV LAW GROUP.

COUNT I

DECLARATION OF EXCLUSIVE OWNERSHIP

10. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 9 of this pleading, inclusive, as fully set forth herein at length.

11. TEV LAW GROUP is entitled to declaration of exclusive ownership of the Mark and all formatives thereof likely to cause confusion.

COUNT II

UNFAIR COMPETITION BY INFRINGEMENT OF COMMON LAW RIGHTS

12. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 11 of this pleading, inclusive, as fully set forth herein at length.

13. Defendant's acts constitute unfair competition and an infringement of TEV LAW GROUP's common law rights in the Mark. The acts by Defendant are unfair competition in violation of the common law of the Commonwealth of Pennsylvania.

14. Defendant's acts as alleged herein were committed with the intent to pass off and palm off Defendant's goods as the goods of TEV LAW GROUP, and with the intent to deceive and to defraud the public.

COUNT III

VIOLATION OF LANHAM ACT BY USE OF FALSE DESIGNATION

IN INTERSTATE COMMERCE

15. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 14 of this pleading, inclusive, as fully set forth herein at length.

16. Defendant's acts are in violation of 15 U.S.C.S. § 1125(a), Defendant has used in connection with the aforesaid goods and/or services a false designation or origin, false or misleading description and representation of fact which is likely to cause confusion,

and to cause mistake, and to deceive as to the affiliation, connection, or association of Defendant with TEV LAW GROUP and as to the origin, sponsorship and approval of Defendant's goods, services and commercial activities by TEV LAW GROUP.

COUNT IV

DILUTION IN VIOLATION OF FEDERAL ANTI-DILUTION STATUTE

17. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 16 of this pleading, inclusive, as fully set forth herein at length.

18. Defendant has made commercial use of the Mark, a designation owned by TEV LAW GROUP, in connection with goods and/or services which Defendant has used and transported in United States interstate commerce. Defendant's acts are in violation of Lanham Act § 43(c) in that they have caused dilution of the distinctive quality of the Mark, all to the irreparable injury to and damage of TEV LAW GROUP.

19. Defendant's acts have lessened the capacity of the Mark to identify and to distinguish the goods of TEV LAW GROUP. Defendant acts have blurred the unique association which have heretofore existed between the Mark and goods made and/or services rendered by TEV LAW GROUP.

20. The Mark is a distinctive and famous mark. The Mark has been used in connection with the goods and services regarding which it appears, are used throughout the world on the Internet to consumers and those in the trade, are in substantially exclusive use, and are registered in this Commonwealth, as alleged heretofore.

21. Defendant committed the acts averred herein willfully and with the intent to cause dilution of the Mark and TEV LAW GROUP's rights and reputation.

COUNT V

VIOLATION OF 73 P.S. 201-1

22. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 21 of this pleading, inclusive, as fully set forth herein at length.

23. The acts by Defendant are unfair competition and are in violation of 73 P.S. 201-1, et seq.

24. Such unfair competition is causing TEV LAW GROUP damage thereby, and TEV LAW GROUP is entitled to statutory treble damages thereby as a result of the intentional actions averred herein.

COUNT VI

COMMON LAW TRADEMARK INFRINGEMENT

25. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 24 of this pleading, inclusive, as fully set forth herein at length.

26. Defendant is acting in an intentional and wanton manner in order to deceive the public by passing off and are thereby causing confusion in the marketplace as to the origin of the services offered, and TEV LAW GROUP is being harmed thereby.

27. Defendant is in violation of 54 Pa. Pa.C.S.A. 1101, et seq.

COUNT VII

INJUNCTIVE RELIEF

28. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 27 of this pleading, inclusive, as fully set forth herein at length.

29. The damages being incurred by TEV LAW GROUP, including the public confusion over the origin of goods and services are of a nature that money alone cannot remedy and TEV LAW GROUP is being irreparably harmed thereby.

COUNT VIII

VIOLATION OF LANHAM ACT BY INFRINGEMENT OF TRADEMARK REGISTRATIONS

30. TEV LAW GROUP hereby incorporates by this reference paragraphs 1 through 29 of this pleading, inclusive, as fully set forth herein at length.

31. Defendant has established a business name and products bearing names which are confusingly similar to one or more the registered Mark.

32. Defendant has infringed upon the federal trademark rights of TEV LAW GROUP in violation of the Lanham Act.

ALLEGATION OF DAMAGES

33. By reason of Defendant acts as alleged herein, TEV LAW GROUP has and will suffer damage to its business, reputation and good

will and the loss of sales and profits TEV LAW GROUP would have made but for Defendant's acts.

34. Defendant threatens to continue to do the acts complained of herein, and unless restrained and enjoined, will continue to do so, all to TEV LAW GROUP's irreparable damage. It would be difficult to ascertain the amount of compensation which could afford TEV LAW GROUP adequate relief for such continuing acts, and a multiplicity of judicial proceedings would be required. TEV LAW GROUP's remedy at law is not adequate to compensate it for injuries threatened.

PRAYER FOR RELIEF

WHEREFORE, TEV LAW GROUP prays:

1. Injunctive Relief. 1(a). Enjoin Defendant. That this Court grant an injunction pursuant to the powers granted it under 15 U.S.C.A § 1116, enjoining and restraining Defendant and its agents, servants and employees from directly or indirectly using the Mark or any other mark, word or name similar to the Mark which is likely to cause confusion, mistake or to deceive.

That this Court, pursuant to the power granted it under 15 U.S.C.S. § 1118, order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of Defendant bearing the Mark and all plates, molds, matrices and other means of making the same, shall be delivered up to the Court for destruction.

1(b). Enjoin Defendant's Agents, Advertisers, Rellers, etc. That this Court grant an injunction enjoining and restraining Defendant and its agents, advertisers, distributors, resellers, servants and employees from (1) directly or indirectly using the Mark or any other mark, word or name similar to the Mark which are likely to cause confusion and (2) continuing any and all acts of unfair competition as herein alleged.

1(c). Specific Performance. That this Court order that Defendant notify all advertisers, agents, internet service providers and other contributing in the infringement to cease and desist contributing to the infringement, including but not limited to causing the re-indexing of all search engines on the Internet as well as transferring any domain names bearing the Mark to TEV LAW GROUP.

2. Declaration. Declare that TEV LAW GROUP has and shall have the exclusive and continued right to continue to use the Domain Name.

3. Accounting. That Defendant be required to account to TEV LAW GROUP for any and all profits derived by Defendant from the sale of its goods and for all damages sustained by TEV LAW GROUP by reason of said acts of infringement and unfair competition complained of herein.

4. All Permissible Damages. 4(a) Compensatory Damages. That the Court award TEV LAW GROUP compensatory damages in an amount to be proven at trial;

4(b) Statutory Damages. That this Court award TEV LAW GROUP statutory damages, pursuant to Federal and Pennsylvania law to the fullest extent provided by the respective statutes averred herein;

4(c) Treble Damages. That this Court award TEV LAW GROUP TREBLE the amount of actual damages suffered by TEV LAW GROUP, pursuant to the statutes providing for such treble damages as averred herein.

4(d) Punitive and Exemplary Damages. That this Court award punitive and exemplary damages against Defendant and in favor of TEV LAW GROUP in a sum to be determined at trial by reason of Defendant's fraud and palming off.

5. Cost of Litigation. That this Court award TEV LAW GROUP the costs of this action.

6. Attorneys' Fees. That this Court award TEV LAW GROUP all of its attorney fees.

7. Additional Damages. Furthermore, that this Court grant such other and further relief as it shall deem to be just and proper.

Dated: July 27, 2005

s/ Gregg R. Zegarelli
Gregg R. Zegarelli, Esq.
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CLIENT UPDATE

Published for the Clients and Friends of Zegarelli Associates Professional Corporation

THE TEAM

Zegarelli Associates is often asked to assist clients in negotiating contracts and business transactions, and, in such cases, clients usually ask if there is a general overriding principal to remember. The answer is basic: Remember the Team!

You must begin by identifying the necessary players on both sides, the goal, and the necessary strategy to achieve the goal. Every member of the team has a primary purpose, and a secondary purpose to assist other members of the team with their primary purpose. You must believe in, rely upon, and unify your team, and, no matter what, you never, ever, allow anyone (including yourself and your own team members) to break down the bonds of your team. But, the first step is to recognize that you need a team, and, then, to develop and coordinate your team. Our experience finds no exception to this rule.

THE END IS BEGINNING

The end of 1994 is approximately one month away! Please take the time to consider your year-end planning. For example, you may want to take certain tax deductions in the current tax year or make contributions to your retirement plan. Or, you may want to end the year by finalizing your estate plan, etc. We can help. For example:

- If you are interested in changing the form of your business entity, such as incorporating, you may want to have the firm file your documents in December, with an effective date of January 1, 1995. This will allow for a smooth transition.
- Given the election results, you may want to consider deferring taxable income (especially capital gains) in 1994. New lower rate credit cards can make it less expensive to make year-end credit card purchases to reduce business income.
- If you are required to make estimated tax payments during the course of the year (typically self-employed, partners, and S corporation shareholders) and had adjusted gross income for 1993 in excess of \$150,000, the safe harbor to

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avoid underpayment penalties is now 110% of prior year tax.

- The 25% health insurance deduction for self-employed individuals, partners and 2% S corporation shareholders has not been reinstated for 1994.
- Although contributions to Keogh plans can be made until April 15, 1995, plans must be established prior to year-end.

CLIENT DIRECTORY!

If we are proud of anything, then we are proud of our clientele. In fact, we are pleased that, over the years, we have come to represent a clientele of unmatched entrepreneurial spirit. So, what's a firm to do? We know all of you, but we think that all of you should know about each other, too. Therefore, we are in the process of preparing a firm client profile. Here's how it works:

- We are asking our business clients to assist us by completing and returning the Profile Questionnaire (which may be enclosed with this *Client Update*) on or before December 12, 1994. Feel free to return the Questionnaire by telecopier.
- The completed Profile will not include names, addresses or telephone numbers of clients. Only a description of products and/or services will be identified.
- Any client interested in meeting another client can call their attorney and request a meeting with the other client (with or without the attorney).
- The Profile will be distributed to clients that decide to participate (by completing the Profile Questionnaire).

The reason to participate is basic: it provides an unmatched opportunity to network with some of the most interesting and exciting entrepreneurs in the region. At a minimum, it provides an advertising referral source. At best, it provides an opportunity for corporate partnering, joint ventures, etc.

RATES & RETAINERS

We are pleased to continue to provide legal services at an hourly rate which remains an excellent value and extremely cost-effective. Please contact your attorney with regard to his or her particular rate for 1995; we now offer a variety of price ranges. We are pleased that the Legal Coordinator rate remains at \$65, and legal assistants at \$45 per hour.

In addition, we continue to offer retainer-based relationships which can

provide an even greater savings for legal services, if services are needed on a more consistent basis. With regard to payment methods, we accept all major credit cards at no additional cost to our clients, and we continue to establish tailored payment plans.

CHECKMARKsm

As you may have heard us say (over and over and over), "protect your trademark." As a result of numerous client requests, beginning on January 1, 1995, we are initiating our Checkmarksm Service. The Checkmark Service is a service provided by Zegarelli Associates to verify the status of your trademark registrations on a consistent basis. The service can be elected for 3-month, quarterly, semi-annual and annual verification.

Stated generally, in accordance with the approved frequency, Zegarelli Associates will automatically perform a computerized search on your trademarks and/or service marks to assist in preventing others from registering similar marks. We will automatically send you the results, and, if it is necessary that we oppose another pending registration, then we will so advise. As you may know, we perform the searches extremely cost effectively: \$25 logon fee, plus research time and actual print charges. Often, the total fee is less than \$50 per logon.

COMPUTER DOCKET PLANNING

Your docket is maintained by the firm to track our "to-do" list for you. Generally, we distribute to you a copy of your docket once per year at year-end. You may request your docket at any time. If we do not distribute a docket to you before year end, then we do not have any pending work identified for you in the computer system. If we send you a copy of the docket, please review it carefully, and call us with any correction. For example, if we list that we are awaiting your directive with regard to a matter, and if you thought we were proceeding, then call us so that we can adjust accordingly.

CLIENT SPOTLIGHT

Zegarelli Associates is pleased to feature:

STRATEGIC EXPOSURE, INC.

in the Client Spotlight. You've always wanted to be in headlines. Here's your chance! This month's feature is a start-up business concern dealing in the complete cost-effective production of marketing newspapers for businesses. Your clients may not even know that they are reading promotional materials. Strategic Exposure is located at 1417 Brownsville Road, Suite 137, Pittsburgh, PA 15227 and may be contacted at 412-884-9445. If you mention the *Client Update*, you will receive a 10% discount from your initial purchase. Strategic Exposure certainly has the entrepreneurial spirit!

[Zegarelli Associates selects the client for the Client Spotlight based upon novelty of business idea, and the legitimate discount offered to the readers of the *Client Update*. Zegarelli Associates does not endorse client products and/or services, and Zegarelli Associates is not otherwise associated with the Client featured. Call for an application to be featured in the Client Spotlight.]

Future Issues of *Client Update*

Future issues of the *Client Update* are expected to have summary articles on Franchising and Sales Tax. Call us with your ideas for future articles.

Contact us today! Our firm can assist you with understanding and applying the law to your particular situation. We Represent the Entrepreneurial Spirit®. If you would like to obtain our other firm publications, please go to our mailing list page.

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